12 contain allowable subject matter. Accordingly, the only remaining issue pivots about the patentability of claims 1-3, 9-11, and 13.

Claims 1, 4-5, and 9-10 have been amended, and new claim 21 has been added. Claim 1 has been amended to clarify that the active regions are proximate to each of the resistor elements. Claims 4 and 5 have been amended to place the claims in independent form by including all of the limitations of the base claim and any intervening claim. Claim 9 has been amended to change the dependency of claim 9 from claim 1 to claim 5. Claim 10 has been amended to clarify that a distance between two resistors elements is set to a shortest distance between patterns formed by a conductive film constituting the same layer as that of the resistor elements, and this amendment finds support throughout the specification, for example, on pages 15-16 and 30. New claim 21 finds support in the specification on pages 18 and 19. Applicants submit that the present Amendment does not generate any new matter issue.

On page two of the Office Action, the Examiner objected to Figs. 13a-13c and 14 of the drawings pursuant to M.P.E.P. § 608.02(g), requiring that which is old be labeled as "PRIOR ART." In response, it is proposed to amend Figs. 13a-13c, as indicated in red on the attached photocopies, to label these figures as prior art. Also, accompanying this Amendment is a Request for Approval of Drawing Amendment and proposed drawing corrections for Figs. 13a-13c with the changes indicated in red ink.

With regard to Fig. 14, Applicants note that Fig. 14 describes characteristics derived from experiments by the Applicants. As such, Applicants do not believe the information in Fig. 14 can be recognized as prior art.

On page two of the Office Action, the Examiner objected to the drawings pursuant to 37 C.F.R. § 1.83(a), requiring the resistor elements surrounded by active regions be shown or deleted from the claims. Applicants respectfully disagree with the Examiner's assertion that this feature is not shown in the drawings and would invite the Examiner's attention to Fig. 6, which illustrates an active region 3 surrounding resistor elements 4. As such, Applicants respectfully request withdrawal of the imposed objection as to the drawings.

On page two of the Office Action, the Examiner asserted that the title of the invention was not descriptive. In response, the Title has been changed to --SEMICONDUCTOR DEVICE WITH RESISTOR ELEMENTS FORMED ON INSULATING FILM--.

On pages two and three of the Office Action, the Examiner objected to the use of the term "contiguous" in the specification as not being descriptive of the features illustrated in the drawings. Applicants refer to RANDOM HOUSE WEBSTER'S COLLEGE DICTIONARY, 294 (1995), wherein the definition for "contiguous" includes "2. being in close proximity without touching; near." In this respect, Applicants respectfully submit that the Figures illustrate the resistor elements are in close proximity to the active regions. As such, Applicants submit that the term "contiguous" has been properly used within the specification and would have been understood by one having ordinary skill in the art.

Claims 1-13 are rejected under the second paragraph of 35 U.S.C. § 112

In the second enumerated paragraph of the Office Action, the Examiner asserted that the term "contiguous," which is found in claim 1, fails to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

As stated above, the term "contiguous" has been correctly used. Also, claim 1 has been amended to replace the term "contiguous" with "proximate," with no intention to limit the scope of the claimed invention. As such, the Examiner's rejection, as pertaining to this term, has been rendered moot.

The Examiner also rejected claim 10 for use of the term "minimum." Claim 10 has been amended with no intention to limit the scope of the claimed invention, and the term "minimum" no longer is found in claim 10. As such, the Examiner's rejection, as pertaining to this term, has been rendered moot.

Claims 1-3, 9-11, and 13 are rejected under 35 U.S.C. § 102(b) for lack of novelty as evidenced by Babcock et al., U.S. P.G. Publication No. US 2002/0033519 A1 (hereinafter Babcock)

In the fourth enumerated paragraph of the Office Action, the Examiner asserted that Babcock discloses a semiconductor device corresponding to that claimed. This rejection is respectfully traversed.

Initially, Applicants note that claim 4 was indicated as being rejected and claim 10 was not indicated as being rejected. However, page one of the Office Action indicates the opposite. Furthermore, in the statement of the rejection, the language pertaining to claim 4 appears to be directed to claim 3, and on page six of the Office Action, claim 4 is indicated as being allowable. Also, there is language on pages four and five of the statement of the rejection that refer to claim 10. As such, Applicants are proceeding under the assumption that claim 4 is allowable and claim 10 is rejected.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that one having ordinary skill in the art would have recognized that the identically claimed invention is within the public domain. **ATD Corporation v. Lydall, Inc.**, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998); **Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.**, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). In deciding the issue of anticipation, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference. **Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). Applicants respectfully submit that the Examiner cannot maintain the rejection of claim 1, as amended, on the basis of lack of novelty as evidenced by Babcock.

Independent claim 1, as amended, recites active regions proximate to each of the resistor elements. Although the Examiner states that "active regions are located to the left and to the

right of the STI," and the Examiner has not identified any specific disclosure in Babcock regarding these features. Notwithstanding Babcock's failure to disclose active region, even if the active regions are found in the locations described by the Examiner, Babcock fails to disclose the active regions are positioned proximate to each of the resistor elements. As illustrated in Fig. 2A of Babcock, all of the structures 60, 70 are formed on a single insulator layer 20, and there is no teaching or suggestion that active regions are proximate to each of the structures 60, 70.

The above argued differences between the semiconductor device defined in independent claim 1 and the teachings of Babcock undermine the factual determination that Babcock identically describes the claimed invention within the meaning of 35 U.S.C. § 102. **Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.**, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); **Kloster Speedsteel AB v. Crucible Inc.**, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, respectfully submit that the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Babcock is not factually viable and, hence, solicit withdrawal thereof.

As claims 2-3, 11, and 13 depend ultimately from independent claim 1, Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Babcock. Thus, Applicants submit that claims 2-3, 11, and 13 are patentable over Babcock at least on the basis of their dependency upon claim 1. Applicants, therefore, respectfully solicit withdrawal of the rejections of claims 2-3, 11, and 13 under 35 U.S.C. § 102 for lack of novelty as evidenced by Babcock.

Claim 3 is rejected under 35 U.S.C. § 103 for obviousness predicated upon Babcock in view of Wolf

In the sixth enumerated paragraph of the statement of the rejection, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the semiconductor device of Babcock with Wolf to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 3 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Babcock. Specifically, Babcock neither discloses nor suggests active regions proximate to each of the resistor elements. The secondary reference to Wolf does not cure the argued deficiencies of Babcock because Wolf also does not teach active regions proximate to each of the resistor elements. Accordingly, the proposed combination of references would not yield the claimed invention. **Uniroyal, Inc. v. Rudkin-Wiley Corp.**, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Applicants, therefore, respectfully submit that the imposed rejection of claim 3 under 35 U.S.C. § 103 for obviousness predicated upon Babcock and Wolf is not factually or legally viable and, hence, solicit withdrawal thereof.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the

Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

Scott D. Paul
Registration No. 42,984

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SDP:cac
Date: July 5, 2002
Facsimile: (202) 756-8087

Version with markings to show changes made

IN THE CLAIMS:

Please amend claims 1, 4, 5, 9 and 10 as follows:

1. (Amended) A semiconductor device having a plurality of resistor elements formed on an insulating film in predetermined regions on a surface of a semiconductor substrate, said semiconductor device comprising

active regions [contiguous with] proximate to each of said resistor elements.

4. (Amended) [The] A semiconductor device [according to claim 3,] having a plurality of resistor elements formed on an insulating film in predetermined regions on a surface of a semiconductor substrate, said semiconductor device comprising:

active regions proximate to each of said resistor elements, wherein

said plurality of resistor elements are arranged on said insulating film,

said insulating film under said resistor elements is set to a predetermined width by said active regions, wherein said predetermined width is defined by an amount of shift in resistance value of said resistor elements, said amount of shift being defined by said predetermined width.

5. (Amended) [The] A semiconductor device [according to claim 1,] having a plurality of resistor elements formed on an insulating film in predetermined regions on a surface of a semiconductor substrate, said semiconductor device comprising:

active regions proximate to each of said resistor elements, wherein

the regions including said active regions are furnished with dummy gate electrodes constituting the same layer as that of said resistor elements.

9. (Amended) A semiconductor device according to claim [1] 5, wherein a plurality of said resistor elements are furnished between any adjacent two of said active regions.

10. (Amended) A semiconductor device according to claim 9, wherein a distance between any adjacent two of said plurality of resistor elements is set to a [minimum space] shortest distance between patterns formed by conductive film constituting the same layer as that of said resistor elements on said semiconductor substrate.

Please add the following new claim:

--21. (New) A semiconductor device according to claim 9, wherein a distance between any adjacent two of said plurality of resistor elements is set to approximately equal to a distance between any adjacent pair of said resistor elements and said dummy gate electrodes.--